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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181621
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.	:	
	:	
Opposer	:	
v.	:	Opposition 91181621
	:	
	:	Application 76/650,832
	:	
Les Pierres Stonedge, Inc.	:	Mark: STONEDGE
	:	
Applicant	:	

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**STONCOR'S PRINCIPAL BRIEF IN SUPPORT  
OF STONCOR'S CASE-IN-CHIEF**

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## Description of the Record

The record in this case includes the Notice of Opposition<sup>1</sup> of Opposer StonCor Group, Inc. (“StonCor”) and StonCor’s incontestable United States trademark registrations for the marks STONHARD, U.S. registration 1,487,280; STONCLAD, U.S. registration 1,706,070; STONKOTE, U.S. registration 1,697,228; STONSHIELD, U.S. registration 1,689,713; STONBLEND, U.S. registration 1,712,857; STONCLAD-PT, U.S. registration 1,306,662; STONCREST, U.S. registration 1,740,723; STONCRETE, U.S. registration 1,645,258; STONFIL, U.S. registration 1,703,299; STONLINER, U.S. registration 1,688,593; STONLOK, U.S. registration 1,655,954; STONLUX, U.S. registration 1,687,420; STONPROOF, U.S. registration 1,697,229; STONSET, U.S. registration 1,691,045; and STONSEAL, U.S. registration 1,697,230. These fifteen incontestable trademark registrations are of record in accordance with 37 CFR 2.122 and as stipulated by counsel:

MR. QUINN: Okay. We also stipulate that the StonCor registrations that were attached to the Notice of Opposition are of record and are in evidence as the --

MR. MENKER: I think the Board already said as much.

MR. QUINN: I believe that – I believe that's correct, but I just wanted to see, make sure that we're in agreement between the two of us to that effect. Okay?

MR. MENKER: Yup, I agree that the registrations are made of record.<sup>2</sup>

The record further includes application 76/650,832 for the mark STONEDGE as filed by Les Pierres Stonedge, Inc. (“Les Pierres”).

The record yet further includes StonCor’s rebuttal testimony given by Mr. Michael Jewell, Vice President of Marketing for StonCor Group, Inc. and StonCor’s Exhibits 1 through

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<sup>1</sup> The Notice of Opposition is StonCor’s Exhibit 1, attached as Appendix A, which was offered in evidence without objection.

<sup>2</sup> Pg. 7, ln. 1-13; transcript of StonCor’s witness Mr. Jewell’s rebuttal testimony.

28 as offered in evidence without objection<sup>3</sup> in the course of Mr. Jewell's testimony, together with a Les Pierres document identified as StonCor's Exhibit 43, all of which accompanied Mr. Jewell's testimony when filed.

Due to the illness of StonCor's counsel, StonCor did not take any testimony during its initial testimony period.<sup>4</sup>

Les Pierres took no testimony during its testimony period, and filed no evidence.

The parties agreed on the record that all deposition testimony and any accompanying exhibits would be filed by the parties and not by the court reporter.<sup>5</sup> StonCor's testimonial deposition and accompanying exhibits were filed with this Board on 22 October 2009.

### **Statement of the Issues**

Registrability requires absence of likelihood of confusion.<sup>6</sup> The evidence is undisputed that Les Pierres' mark STONEDGE is highly similar in appearance, sound and connotation to StonCor's incontestable registered marks STONFIL, STONLOK, STONSET, STONCRETE and STONLINER, as well as others of StonCor's marks. Les Pierres seeks registration of STONEDGE for "precast decorative stone", which is installed using adhesive, grout or mortar, all sold by StonCor under StonCor's incontestably registered marks STONFIL, STONLOK, STONSET, STONCRETE and STONLINER. When all of the *duPont* evidence favors StonCor and its "S T O N" marks STONFIL, STONLOK, STONSET, STONCRETE and STONLINER, should registration for STONEDGE be refused?

The law protects families of marks, especially families of long-registered marks, from encroachment by poachers appropriating the formative defining the mark family. StonCor's

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<sup>3</sup> Pg. 98 of StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>4</sup> When StonCor's counsel had recovered, StonCor moved to reopen StonCor's testimony period; that motion was denied, as was a request for reconsideration.

family of “S T O N” marks, defined by the trade-recognized formative “S T O N”, includes STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL, all which registrations are incontestable and nearly all of which are for goods very closely related to Les Pierres’ STONEDGE precast decorative stone. With Les Pierres’ STONEDGE mark appropriating StonCor’s trade-recognized formative “S T O N” and seeking registration for “precast decorative stone”, which is closely related to StonCor’s mortar, grout, and adhesive products, as well as to the goods for which others of StonCor’s “S T O N” marks are registered, should StonCor’s family of “S T O N” marks, including STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL, be protected from encroachment and the dilution that would result if Les Pierres’ STONEDGE is registered?

Preference respecting registration is accorded senior users and registrants such as StonCor; evidence is to be viewed most favorably to such registrants. Les Pierres, as a junior applicant, receives no such preference and obtains no favorable evidentiary presumptions relative to registrant StonCor. When applicant Les Pierres presents no testimony or documentary evidence in support of registration, relying solely on its pending application to support its position, and when the testimonial and documentary evidence all favors StonCor, should Les Pierres’ application for registration be denied?

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<sup>5</sup> Pg. 6, ln. 2-11, transcript of StonCor’s witness Mr. Jewell’s rebuttal testimony.

<sup>6</sup> *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A 1973).

## Recitation of the Facts

Opposer StonCor manufactures, sells, and installs, *inter alia*, a variety of flooring, coating, sealing and bonding products, including mortars, grouts and adhesives for bonding and securing stone, concrete, and other cementitious materials, and products made thereof.<sup>7</sup>

StonCor's flooring, sealing and bonding products are particularly adapted for use in new construction and in rehabilitation of masonry and concrete buildings, and other structures made of such materials.<sup>8</sup> Relevant to this proceeding are StonCor's self-leveling floor<sup>9</sup> products and StonCor's "complementary" products, including StonCor's mortars, grouts and adhesives, which undisputedly may be used to install Les Pierres' STONEDGE precast decorative stone products:

Q. The application for registration of Stonedge is for use of that mark in connection with precast decorative stone. Isn't it true that StonCor makes products that can be used to -- in the assembly or construction of structures from such precast decorative stone --

A. Yes, it's true.

Q. -- under the mark Stonedge?

A. Yes, it's true, we manufacture several products that could be used in the assembly and construction with these types of stones.<sup>10</sup>

For years StonCor and its predecessors in interest have made, sold and installed products in interstate commerce under trademarks commencing with the four letter formative "S T O N", followed by other letters. Sales of these products under at least the StonCor mark STONHARD commenced at least as early as sometime in the 1920's and continue to date. Sales of products under others of the StonCor "STON..." marks commenced in the late 1980's and early 1990's and have been continuous to date. All such sales in interstate commerce commenced long prior

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<sup>7</sup> See StonCor's Exhibits 3, 8, 10 and 22 through 24 for more details on StonCor's products.

<sup>8</sup> Pg. 40, ln. 6-13; StonCor's Exhibit 3, a copy of which is attached as Appendix B.

<sup>9</sup> StonCor's flooring products are "self leveling". A self-leveling floor is installed by introducing a mixture of epoxy, epoxy hardener, aggregate and optional additives into an open top framework, mechanically "working" the exposed upper surface of the mixture to smooth it, and thereafter permitting the mixture to cure to a high degree of hardness as the epoxy chemically reacts with the hardener, entrapping the aggregate and the additives within the hardened mixture. Once curing is complete a sealant may be applied, if necessary, to the exposed upper surface. StonCor's Exhibit 3 attached as Appendix A illustrates these self-leveling floors and their installation in detail.

<sup>10</sup> Pg. 100, ln. 6-17; StonCor's witness Mr. Jewell's rebuttal testimony.



to the filing date of Les Pierres' application that is the subject of this opposition. StonCor's sales have been substantial, with StonCor installing between 10,000 and 15,000 self-leveling floors alone, annually in the United States, having a value of about one hundred million dollars:

Q. And about how many projects or sales do you make annually of the flooring product?

A. Somewhere between 10 and 15,000 individual contracts a year.

Q. In the United States?

A. In the United States.

Q. And what would be the approximate dollar value of that?

A. About right around \$100 million annually in the United States.

Q. In the United States?

A. Yes.<sup>11</sup>

StonCor's flooring products are installed principally in commercial, industrial, institutional, and academic buildings; StonCor does not sell to consumers. StonCor promotes its flooring products to architects, contractors and others in the construction field. Based on Mr. Jewell's testimony above, StonCor has installed more than 40,000 flooring projects in the United States since Les Pierres first used its mark in Canada on 21 June 2005.<sup>12</sup> There is no evidence of any use by Les Pierres of its mark in the United States.

As a result of the long, uninterrupted, exclusive and continuing use of StonCor's marks in interstate commerce, throughout the United States, on and in connection with StonCor's flooring, coating and complementary products, including adhesive, grout and mortar, and StonCor's associated product installation services, StonCor's "STON..." marks, namely STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL, individually and collectively, together with the formative prefix "S T O N", are recognized by architects and those in the building trades as StonCor's family of marks. Those

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<sup>11</sup> Pg. 13, ln. 22 through pg. 14, ln. 9; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>12</sup> The certified copy of Les Pierres Canadian registration provides this date.

marks (i) identify StonCor as the source of origin of products sold under StonCor's marks, and (ii) denote the high quality of those StonCor products. Consequently, StonCor owns nationwide common law rights, as well as exclusive statutory rights through registration as detailed below<sup>13</sup>, for StonCor's marks STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL, as StonCor's Mr. Jewell testified:

Q. So would you look, please, Mr. Jewell, at the attachments to the Notice of Opposition and check as to the ownership listed for each one.

A. (At which time the Witness reviews the document). Okay. All of the marks with the exception of one lists StonCor Group, Inc. as the owner. And that one lists Stonhard, Inc. as the owner, that would be for the mark Stonlok. All the others list StonCor Group, Inc.

Q. And with respect to Stonlok it is correct, is it not, that when Stonhard, Inc. changed its name to StonCor, Group, Inc., that that was the only -- there was no transfer of assets associated with that -

A. That's correct.

Q. -- name change, correct?

A. It was just a name change, corporate name change.

Q. So StonCor Group may not be listed there as the owner, but it is, in fact, the owner of that registration?

A. That is correct.<sup>14</sup>

Registration of Les Pierres' mark STONEDGE is sought for "precast decorative stone".

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<sup>13</sup> The StonCor family of marks includes the incontestable registrations for the marks STONHARD, U.S. registration 1,487,280; STONCLAD, U.S. registration 1,706,070; STONKOTE, U.S. registration 1,697,228; STONSHIELD, U.S. registration 1,689,713; STONBLEND, U.S. registration 1,712,857; STONCLAD-PT, U.S. registration 1,306,662; STONCREST, U.S. registration 1,740,723; STONCRETE, U.S. registration 1,645,258; STONFIL, U.S. registration 1,703,299; STONLINER, U.S. registration 1,688,593; STONLOK, U.S. registration 1,655,954; STONLUX, U.S. registration 1,687,420; STONPROOF, U.S. registration 1,697,229; STONSET, U.S. registration 1,691,045; and STONSEAL, U.S. registration 1,697,230. StonCor additionally owns U.S. registration 2,978,818 for the mark STONCHEM; U.S. registrations 3,694,310 and 3,700,433 for the mark STONTEC; U.S. registration 3,707,544 for the mark STONHARD; application 77/518,576 for the mark STONGLAZE; application 77/698,756 for the mark STONKLEEN; application 77/891,386 for the mark STONFLEX; and application 77/891,523 for the mark STONRES. StonCor further owns the presently unregistered mark STONCOR, and the trade names "Stonhard", "StonCor" and "StonCor Group". Two title and status photocopies of each of the incontestable registrations listed above accompanied the notice of opposition in accordance with 37 CFR 2.122(d)(1) and hence are of record and in evidence. The StonCor family of marks is sometimes referred to herein as the "StonCor Marks" or as "StonCor's 'STON...' " marks.

<sup>14</sup> Pg. 96, ln. 23 through pg. 97, ln. 23; StonCor's witness Mr. Jewell's rebuttal testimony.

StonCor filed a notice of opposition against registration of Les Pierres' mark on 20 December 2007. In the notice StonCor asserted that it owned a family of registered trademarks, all commencing with the letters "S T O N", for construction materials used largely for making floors, and for related building products including mortar and grout, and alleged damage if Les Pierres' mark STONEDGE was registered.

StonCor's products are promoted and sold by its employees to architects, building contractors and others in the construction field:

Q. Are those products sold through salaried representatives, or commission salespersons, independent reps or what?

A. Yeah, our sales force is a combination of salaried and commissioned employees. So our sales force of about 150 are all direct employees. There are no sales - there are no agents or reps.<sup>15</sup>

### **Summary of the Argument**

StonCor's evidence respecting the *duPont*<sup>16</sup> factors is undisputed: Les Pierres' mark STONEDGE is highly similar in appearance, sound and connotation to StonCor's marks STONFIL, STONLOK, STONSET, STONCRETE and STONLINER, as well as other of StonCor's "STON ..." marks. The precast decorative stone for which Les Pierres seeks registration of STONEDGE may be installed using (and so is related to) StonCor's adhesive, grout and mortar products sold under StonCor's marks STONFIL, STONLOK, STONSET, STONCRETE, and STONLINER. Since all of the *duPont* evidence favors registrant StonCor and its "STON" marks STONFIL, STONLOK, STONSET, STONCRETE and STONLINER, as well as StonCor's other "STON..." marks, registration for STONEDGE should be refused.

The law especially protects families of long-registered marks from encroachment by junior users appropriating the formative defining the mark family. StonCor's family of "S T O

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<sup>15</sup> Pg. 13, ln. 14 through 20; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>16</sup> *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A 1973).

N... ” marks, defined by the trade-recognized formative “S T O N”, includes STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL, all which registrations are incontestable and nearly all of which are for goods closely related to Les Pierres’ precast decorative stone. With Les Pierres’ mark appropriating StonCor’s trade-recognized formative “S T O N” and seeking registration for precast decorative stone, which is closely related to, and may be installed using, StonCor’s mortar, grout, adhesive, and which is also close to goods for which StonCor’s other “S T O N” marks are registered, StonCor’s family of “S T O N” marks including STONHARD, STONCLAD, STONKOTE, STONSHIELD, STONBLEND, STONCLAD-PT, STONCREST, STONCRETE, STONFIL, STONLINER, STONLOK, STONLUX, STONPROOF, STONSET, and STONSEAL should be protected from encroachment and the dilution that would result if Les Pierres’ STONEDGE is registered.

Registration preference is accorded to registrants such as StonCor; evidence is to be viewed most favorably to such registrants. Les Pierres, as a junior applicant, receives no such preference and obtains no favorable evidentiary presumptions relative to registrant StonCor. With Les Pierres presenting no testimony or documentary evidence in support of registration and with the testimonial and documentary evidence all favoring StonCor, Les Pierres application for registration should be denied.

## Argument

### Introduction

In this opposition proceeding StonCor as opposer has the burden to establish that Les Pierres has no right to register STONEDGE.<sup>17</sup> Les Pierres' trademark application receives no favorable evidentiary presumptions; there is no other evidence favoring Les Pierres. As senior user and registrant, all evidentiary presumptions must be drawn in favor of StonCor.<sup>18</sup>

### The *duPont* Factors Favor StonCor

Likelihood of confusion determinations<sup>19</sup> are made in view of *duPont*,<sup>20</sup> under which the following factors are to be considered in evaluating a mark for registration:

In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" v. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.

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<sup>17</sup> *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339 (C.C.P.A. 1957); *Sanyo Watch Co. v. Sanyo Electric Co.*, 691 F.2d 1019, 215 USPQ 833 (Fed. Cir. 1982).

<sup>18</sup> *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987).

<sup>19</sup> The test for likelihood of confusion is the same whether applied in *ex parte* determinations under 15 USC 1052(d), a trademark opposition proceeding such as this one, or in an infringement action. *Midland International Corp. v. Midland Cooperatives, Inc.*, 434 F.2d 1399, 168 USPQ 107 (C.C.P.A. 1970).

<sup>20</sup> *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
  - (a) a mere “consent” to register or use.
  - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
  - (c) assignment of mark, application, registration and goodwill of the related business.
  - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

...

The evidentiary elements are not listed above in order of merit. Each may vary from case to case to play a more dominant or less dominant role.<sup>21</sup>

The likelihood of confusion issue may be framed as whether Les Pierres’ mark is sufficiently similar in overall commercial impression to one or all of StonCor’s marks that confusion as to some of the associated goods is likely:

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion,

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<sup>21</sup> *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357 at 1361-62 (C.C.P.A 1973).

as to the source of the goods and/or services offered under the respective marks, is likely to result.<sup>22</sup>

People, including those in the construction industry, rely on imperfect recollections thereby to often poorly distinguish marks.<sup>23</sup>

Considering *duPont* factor one, the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression<sup>24</sup>, Mr. Jewell testified on behalf of StonCor as to the high similarity in appearance of Les Pierres' mark STONEDGE as respecting StonCor's "STON..." marks.<sup>25</sup>

And you find some similarity in appearance --

A. Yes.

Q. -- as between the mark STONEDGE and any or all of StonCor's marks?

A. Yes, to many of our marks, yeah. It's similar in length, same number of letters in many cases.

Q. So in your judgment someone seeing the mark Stonedge, a general contractor, for example, might understand that to be a member of the StonCor family of marks?

A. Yes, especially if he sees it in a typed specification or a document such as that.

Q. Because in that -- that would be in text, is that --

A. In text.<sup>26</sup>

....

With respect to the mark Stonedge that is the subject of the application that's been filed by Les Pierres, that mark -- strike. Do you believe that mark is similar in appearance to one or more of the StonCor marks?

A. Yes, I believe it's similar in appearance to most of our marks.

Q. Give me the specific marks or mark to which you believe is similar in appearance.

A. Stonclad, Stonblend, Stonshield, Stonhard itself, Stonlux, Stoncrete, Stonset, Stonfil, Stoncrest, Stonlok, Stonproof, Stonkote, all of them.<sup>27</sup>

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<sup>22</sup> *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (C.C.P.A. 1976).

<sup>23</sup> *Black and Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482 (T.T.A.B. 2002).

<sup>24</sup> With Les Pierres' mark STONEDGE being presented in the application in typed letters, it is appropriate to present evidence of StonCor's use of its marks. *Phillips Petroleum Co. v. C. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (C.C.P.A. 1971); *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

<sup>25</sup> For most purposes in this proceeding the terms "Stonhard", "StonCor" and "StonCor Group" are interchangeable. "STONHARD" is a registered trademark of StonCor Group, Inc.; "Stonhard" is also the name of the division of StonCor Group, Inc. that sells the products relevant to this proceeding; hence "Stonhard" also functions as a trade name. "StonCor" is used herein as an abbreviation for "StonCor Group" and for "StonCor Group, Inc." "StonCor Group" is another of StonCor's trade names while "StonCor Group, Inc." is StonCor's corporate name.

<sup>26</sup> Pg. 40, ln. 19 through pg. 41, ln. 12; StonCor's witness Mr. Jewell's rebuttal testimony.

Les Pierres did not cross-examine Mr. Jewell and presented no evidence contrary to Mr. Jewell's testimony as set forth immediately above. Accordingly, it is undisputed that there is high visual similarity of Les Pierres' mark STONEDGE to StonCor's "STON..." marks, including STONFIL, STONSET, STONCREST, STONLOK, and STONCRETE.

Concerning similarity/dissimilarity in sound as between Les Pierres' mark and StonCor's various marks, StonCor's witness Mr. Jewell testified that there is similarity in sound as between many of StonCor's "STON..." marks and Les Pierres' STONEDGE mark:

Q. You think there is -- in your judgment is there similarity in sound as between Stonedge and StonCor's mark or marks?

A. There's similarity in sound in terms of they both start with the sound "stone." They're both only two syllables. And, you know, so when you look -- even when you look at it visually, it looks the same.

Q. And that applies to one or all of StonCor's marks?

A. All of Stonhard's marks -- StonCor's marks.<sup>28</sup>

.....

Q. With respect to the mark Stonedge that is the subject of Les Pierres' application for registration, do you find that mark to be similar in sound to any of StonCor's marks?

A. Yes, to all of them.<sup>29</sup>

Les Pierres did not cross-examine Mr. Jewell, did not offer any testimony, did not submit any notice of reliance regarding any documentary evidence, and hence has no evidence comparing the sound of Les Pierres' mark to any of StonCor "STON..." marks. With Les Pierres failing to adduce testimony or present other evidence on sound similarity/dissimilarity, and in view of Les Pierres' being the junior user in this proceeding, it is StonCor's rebuttal testimony by Mr. Jewell regarding similarity in sound, and his conclusion respecting likelihood

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<sup>27</sup> Pg. 99, ln. 1-14; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>28</sup> Pg. 40, ln. 7-18; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>29</sup> Pg. 99, ln. 15-19; StonCor's witness Mr. Jewell's rebuttal testimony.



of confusion as between Les Pierres' STONEDGE mark and several of the StonCor "STON..." marks, that must be accorded preference and substantial evidentiary weight.

As to the connotation of Les Pierres' STONEDGE mark versus that of StonCor's STON... marks, both parties' marks connote hardness -- all of the marks commence with the letters "s t o n," which not coincidentally is the trade-recognized formative defining the StonCor family of marks. Here is StonCor's Mr. Jewell's testimony:

Q. With respect to the mark Stonedge that is the subject of Les Pierres' application for registration, do you find the connotation of that mark to be similar to any or all of StonCor's marks?

A. Well, I find it to be confusing with our marks. In terms of it's a building product and a building material. And it could be connoted -- or connotated that it is somehow associated with our company.<sup>30</sup>

Les Pierres did not cross-examine Mr. Jewell<sup>31</sup> and presented no evidence regarding connotation or commercial impression of STONEDGE. Contrasting, StonCor's "STON..." marks, as testified by Mr. Jewell, convey the favorable commercial impression of a group of marks identifying the source of origin of high quality flooring, lining and related construction products, including, adhesives, grouts and mortars, all of which products<sup>32</sup> and marks are well known to those in the architectural, construction and building fields.<sup>33</sup>

The favorable commercial impression enjoyed by StonCor's "STON..." marks stems in part from the extensive sales and installation of flooring, and the associated sales of complementary products used to install the flooring, all under the StonCor "STON..." marks:

Q. And about how many projects or sales do you make annually of the flooring product?

A. Somewhere between 10 and 15,000 individual contracts a year.

Q. In the United States?

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<sup>30</sup> Pg. 99, ln. 20 through pg. 100, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>31</sup> Pg. 98, ln. 6-8; transcript of StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>32</sup> The products sold under the StonCor marks, when properly mixed, applied and cured, are all very hard; one might say "hard as rock."

<sup>33</sup> Pg. 38, ln. 5 through pg. 43, ln. 10; StonCor's witness Mr. Jewell's rebuttal testimony.

- A. In the United States.  
Q. And what would be the approximate dollar value of that?  
A. About right around \$100 million annually in the United States.  
Q. In the United States?  
A. Yes.<sup>34</sup>

Extensive use of the StonCor “STON...” marks has resulted in those marks acquiring secondary meaning, denoting StonCor as the source of StonCor’s products. As Mr. Jewell testified, StonCor’s individual marks and StonCor’s family of marks are well known in the construction field and serve to distinguish StonCor’s products from those of its competitors. Here is Mr. Jewell’s testimony:

- Q. Just read those titles so we're sure for identification where you're referring.  
A. Masonry, pillar caps, slabs, steps, stone veneers and walls.  
Q. And does StonCor make and sell any products that could be used in the installation of these masonry, pillar caps, slabs, steps, stone veneers and walls?  
A. Our cementitious and polymer modified mortars and grouts could be used in the application of stone block, brick, masonry, those types of things.  
Q. The type of thing that we're seeing here; is that what you're saying?  
A. It is possible, yes.  
Q. And what trademarks are those products sold under?  
A. Stoncrete, Stonset, Stonlok, Stonfil.  
Q. And all of the packages of those trademarks would also bear -- or those products, pardon me, all of the packages of any such products would also bear the mark Stonhard --  
A. Yes.<sup>35</sup>

Still further respecting the commercial impression conveyed by StonCor’s “STON...” marks, unbiased third party survey evidence, as authenticated by Mr. Jewell, clearly indicates that the commercial impression conveyed by the StonCor marks is favorable, with those marks being well-recognized in the construction field:

- Q. And what is the significance of this page to StonCor and to this proceeding?

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<sup>34</sup> Pg. 13, ln. 22 through pg. 14, ln. 9; StonCor’s witness Mr. Jewell’s rebuttal testimony.

<sup>35</sup> Pg. 29, ln. 20 through pg. 30, ln. 19; StonCor’s witness Mr. Jewell’s rebuttal testimony.

A. We -- we advertise frequently in Food Processing. And once a year Food Processing does an unaided survey where they ask various questions to their respondents. For example, in our case, to name a flooring material or name a flooring supplier to -- they ask a series of questions for them to identify companies that they recognize as the leader in a market space. Or just unaided, name, you know, all the flooring companies that you can think of. And in the bottom left corner you can see the category of flooring. And 24 percent of the time Stonhard was named as -- as a flooring company or as a, you know, quality provider of flooring. I'm not certain as to the nature of the question. So we were ranked number 1. And the number 2 is Tufco and they were 7 percent of the time recognized in the survey.<sup>36</sup>

...

Q. And would you identify that exhibit?

A. This is a page from a magazine, I'm trying to see here. It's probably Food Processing magazine again. Reader's Choice Awards for 2007. And, again, this is the section or the category Equipment & Packaging. And Stonhard would be the -- well, Flooring is one of the categories. And Stonhard is listed number 1, again, referenced 23 percent of the time. And like the previous one, Tufco is number 2 at 16 percent of the time.

Q. So what is the relevance of this particular piece, Exhibit 5 -- 6, pardon me, to this proceeding?

A. Yes, like 5, the relevance here is that Stonhard is, at least in this venue, Food Processing, the most widely recognized name in the marketplace.<sup>37</sup>

...

Would you tell -- identify what this exhibit is and tell us the relevance to this proceeding?

A. Page from Food Processing Magazine.

Q. What is the date?

A. March 2009. Also Reader's Choice Awards for Equipment, Packaging & Services. Bottom left is Flooring category. Again, Stonhard is number 1, ranked at 25 percent. Sherwin Williams, one of our competitors and Tufco are tied for the second place position at 14 percent of the time.

Q. So, again, does that demonstrate goodwill and recognition of the mark --

A. To us --

Q. -- Stonhard?

A. Yes, to us, again, it represents the wide recognition of the mark Stonhard in the marketplace.<sup>38</sup>

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<sup>36</sup> Pg. 63, ln. 9 through pg. 64, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony concerning StonCor's Exhibit 5, a copy of which accompanies this brief as Appendix C.

<sup>37</sup> Pg. 64, ln. 11 through pg. 65, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony concerning StonCor's Exhibit 6, a copy of which accompanies this brief as Appendix D.

<sup>38</sup> Pg. 65, ln. 13 through pg. 66, ln. 7; StonCor's witness Mr. Jewell's rebuttal testimony concerning StonCor's Exhibit 7, a copy of which accompanies this brief as Appendix E.

When the sales calls by StonCor's representatives are coupled with the number of floors StonCor installs in a year and the favorable results of third party surveys in the field, it necessarily follows that the commercial impression of StonCor's "STON..." marks is favorable and that of high quality.

In summary, StonCor's evidence of similarity of the competing marks in their entirety as to appearance, sound, connotation and commercial impression is substantial and unrebutted. Had StonCor relied solely on the registrations of its "STON" marks, likelihood of confusion could be found on just the basis of the goods set forth in StonCor's "STON" trademark registrations. With StonCor presenting evidence of use of its registered marks, StonCor is entitled to rely not only on its family of registered "STON..." marks, but also on StonCor's use of those marks as per StonCor's evidence of record.<sup>39</sup>

Because StonCor is the senior user and the evidence must be viewed most favorably to a senior user, and further because Les Pierres presented no evidence on the appearance similarity issue, no evidence in the sound similarity issue, and no evidence on the connotation similarity issue, *duPont* factor one favors StonCor.

Regarding *duPont* factor two, namely the similarity or dissimilarity in nature of the goods or services as described in the application for registration, as Mr. Jewell testified, the precast decorative stone products for which Les Pierres seeks registration of STONEDGE could be installed using StonCor's mortars or other products sold under StonCor's marks STONFIL, STONSET, and STONCRETE:

Q. Would you tell us what Exhibit 8 is, identify it for us?

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<sup>39</sup> *San Francisco Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (C.C.P.A. 1977); *Squirtco v. Tom Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

A. Exhibit 8 is a packet of product literature, product data sheets for various Stonhard products. It's all product data sheets.

Q. And they are for what products?

A. Stonblend GSI, Stonclad GR, Stonclad GS, Stonclad UR, Stoncrete HS1, Stonfil OP2, Stonset QS5. Unless I missed something, that's all of them.

Q. And the products Stoncrete, Stonfil, and Stonset are products you've previously testified could be used to install a Stonedge cap and other --

A. They could be, yes.<sup>40</sup>

From the foregoing, the parties' goods<sup>41</sup> go together essentially hand-in-glove, as per StonCor's Mr. Jewell. All of StonCor's products are promoted to architects, building owners, general contractors, specification writers, and others in the construction field, just as Les Pierres' are presumed to be:

Q. And to whom do you approach when you're going to try to make a sale, what -- better -- better -- withdraw that. What type of -- or what would be the typical position of the individual you would approach in an organization when you go to make a sale?

A. Depending on the application in the market, we sell to the end user, the actual building owner in many cases. So if there's a food processing facility, we would call directly on and sell directly to that plant location. In the case of commercial work, new construction, many times we're selling to -- or the majority of the time we're selling to a general contractor. And we would be calling on and making sales calls and promoting our sales to those general contractors. In addition, we have a small sales team of about 15 that call on and sell to architects and specifiers, because in the new construction side of our business a vast majority of that work is guided by specification of the product.

Q. Do your people call on architects?

A. Yes.

Q. Is an architect what you would specify as a specifier?

A. Yes, architects, engineers and specification writers.<sup>42</sup>

Les Pierres did not cross-examine Mr. Jewell, took no testimony of its own, and presented no documents by way of a notice of reliance or otherwise, to controvert Mr. Jewell's testimony. Here is more of Mr. Jewell's testimony respecting the related nature of StonCor's and Les Pierres' products:

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<sup>40</sup> Pg. 66, ln. 15 through pg. 67, ln. 6; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>41</sup> For technical details of StonCor's products sold under StonCor's marks, STONFIL, STONSET, STONCRETE, as well as StonCor's products sold under StonCor's marks STONBLEND and STONCLAD, see the product data sheets that are StonCor's Exhibit 8, attached hereto as Appendix G.

Q. And what are the product -- or how would you describe the product that's shown there on document -- page 0009 of Exhibit 43<sup>43</sup>?

A. Well, according to the -- the heading on the document, it's a pillar cap, which I imagine in this picture is the very top of those pillars. And it appears to be made of either stone or some sort of composite material. And it's all printed in French, so...

Q. On the basis of what you're inferring or the implications you're taking from the document there and the -- the assumption you're making about the product, how would that product be installed?

A. By -- by whom or how?

Q. No. How? What materials would be used; what would be done; how would it be installed?

A. I would -- my estimate it would be installed using either mortar or an adhesive to -- to build the pillars and cap them. Generally, it's either a cement mortar or some sort of polymer modified mortar or adhesive that's used to hold these things together.

Q. And does StonCor make and sell any product or products that could be used to fulfill that function?

A. We make products that could be used as the mortar or adhesive layers, not the actual capping stone.

Q. And what trademarks are those products sold under?

A. Stonlok, Stoncrete, Stonset, Stonfil are all used for those types of -- could be used for those types of applications.<sup>44</sup>

...

Q. Just read those titles so we're sure for identification where you're referring.

A. Masonry, Pillar Caps, Slabs, Steps, Stone Veneers and Walls.

Q. And does StonCor make and sell any products that could be used in the installation of these masonry, pillar caps, slabs, steps, stone veneers and walls?

A. Our cementitious and polymer modified mortars and grouts could be used in the application of stone block, brick, masonry, those types of things.

Q. The type of thing that we're seeing here; is that what you're saying?

A. It is possible, yes.

Q. And what trademarks are those products sold under?

A. Stoncrete, Stonset, Stonlok, Stonfil.

Q. And all of the packages of those trademarks would also bear -- or those products, pardon me, all of the packages of any such products would also bear the mark Stonhard --

A. Yes.<sup>45</sup>

...

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<sup>42</sup> Pg. 12, ln. 6 through pg. 13, ln. 13, StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>43</sup> Exhibit 43, concerning which Mr. Jewell was testifying, is a collection of Les Pierres' STONEDGE promotional literature. Selected pages of Exhibit 43 accompany this brief as Appendix J.

<sup>44</sup> Pg. 27, ln. 12 through pg. 28, ln. 24; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>45</sup> Pg. 29, ln. 20 through pg. 30, ln. 19; StonCor's witness Mr. Jewell's rebuttal testimony.

Would you turn to page LPS0025 of Exhibit 43?

A. Okay.

Q. And what -- and what do you see there?

A. It's another specification page for Stonedge Series Techno-Bloc.

They appear to be -- well, this says 45-degree corners. So it's a block with a beveled edge on it.

Q. And could -- could the same -- how would these pieces be installed?

A. Well, based on the photograph at the bottom, they appear to be used to -- if they're used on a wall surface, I would guess where the -- a corner meets or if they -- you just wanted a beveled edge on your -- on your, you know, wall or whatever that you were building.

Q. And would any of the StonCor products that you described earlier, the mortars and grouts be used in such installation?

A. They could be, yes.<sup>46</sup>

...

That is page LPS0026<sup>47</sup>. What do you see there?

A. Techno-Bloc Stonedge Series, Chantilly II, which appears to be some sort of a stone or a simulated stone.

Q. Is it a facing?

A. It looks like a -- yeah, it's large rock face. So it appears to be a facing or a cladding-type material.

Q. And could the StonCor materials -- products that we mentioned earlier be used in the installation of these facing material?

A. They could be, yes.<sup>48</sup>

...

Could you turn to page 0034 of Exhibit 43?

A. Okay.

Q. And tell us, what is that page?

A. It's installation instruction for pillar caps or pillars, building a pillar and capping it.

Q. And would you -- do you see where it says in the lower left-hand side, Creating a pillar?

A. Yes.

Q. Would you read the fourth sentence or paragraph underneath the heading of Creating a Pillar?

A. It is also important to adequately glue each row in order to obtain a stable pillar.

Q. Does StonCor make an adhesive product that could be used for that purpose?

A. Yes.

Q. And what is that product, what trademark is that?

A. Stonlok.

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<sup>46</sup> Pg. 32, ln. 18 through pg. 33, ln. 14; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>47</sup> Page LPS 0026, concerning which Mr. Jewell testified, was another page Les Pierres STONEDGE promotional literature forming a part Exhibit 43.

<sup>48</sup> Pg. 33, ln. 17 through pg. 34, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony.

Q. It's sold under the trademark Stonlok?  
 A. Stonlok, as well as Stonset.  
 Q. And do you see in the -- up above there, above the drawings where it says Note?  
 A. Yes.  
 Q. What does it say after Note?  
 A. Techno-Bloc suggests applying concrete adhesive glue between each layer of the pillar kit.  
 Q. And does StonCor make a product that could be used for that function?  
 A. Yes.  
 Q. And that product is sold under what trademark?  
 A. Stonlok and Stonset.<sup>49</sup>

Unquestionably the parties goods are, at the very least, closely related. Respecting *duPont* factor two, the similarity/dissimilarity of the parties goods, StonCor's goods and Les Pierres' goods are complementary at a minimum. As a result, *duPont* factor two weighs in favor of registrant and senior user StonCor.

*duPont* factor three, the similarity of established and likely to continue trade channels, is identical for both parties. Mr. Jewell testified as to promotion of the respective parties' products to building contractors, architects, building superintendents and the like:

Q. I direct your attention to the mark Stonedge as it appears in the upper left-hand corner of that page.  
 A. Yes.  
 Q. Do you find some resemblance there between that mark and the marks of StonCor?  
 A. Yes, very much.  
 Q. And on what -- what do you -- what do you find -- what is it that makes you say there's some resemblance?  
 A. Well, it starts with -- it starts with S-t-o-n, because they capitalize the "E," it draws attention to the fact that it's just S-t-o-n and not S-t-o-n-e and that's identical to every mark that Stonhard has filed and owns.  
 Q. What is identical, the S-t-o --  
 A. The S-t-o-n as the first half of the name.  
 Q. Based on your perusal of Exhibit 43 and the products sold by the Applicant under the mark Stonedge, would those products be sold for use in the same -- any of the same applications or markets to whom StonCor promotes its products?

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<sup>49</sup> Pg. 34, ln. 21 through pg. 36, ln. 9; StonCor's witness Mr. Jewell's rebuttal testimony.



A. Under -- just based on looking at the products themselves, they could be used in commercial construction or those types of applications. Although, many of the photos and things they show are not that. But it's not -- it's not uncommon to see these types of materials used in commercial space, retail, you know, schools, hospitals, those types of applications.

Q. In the public spaces?

A. In the public space, yes.

Q. And StonCor sells flooring for those public spaces --

A. Yes.

Q. -- correct?

A. Yes.<sup>50</sup>

In addition to that set forth above, here is additional testimony by Mr. Jewell on behalf of StonCor:

Q. You think a general contractor seeing a package of precast decorative stone labeled Stonedge might think that that was a product of StonCor?

A. It's possible. It depends on how the package is presented and -- and the typeface and -- and whatever used to identify the product.<sup>51</sup>

...

And the same question with respect to a general contractor hearing about a, quote, precast decorative stone product and hearing that the product was sold under the mark Stonedge, would he believe that product was a product of StonCor?

A. He could certainly believe that.<sup>52</sup>

Q. Do you think it likely that an architect seeing the mark Stonedge would think that denoted a product of StonCor?

A. I think likely, yes.

Q. You think it's likely that an architect hearing the mark Stonedge pronounced would believe that mark identified a product of StonCor?

A. Yes.<sup>53</sup>

Where an applicant, such as Les Pierres, seeks a registration not restricted to sales to any particular class of customers or in any particular channels of trade, the goods are presumably purchased by all classes of customers.<sup>54</sup> Since Les Pierres did not recite any limitations in its

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<sup>50</sup> Pg. 38, ln. 5 through pg. 30, ln. 21; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>51</sup> Pg. 41, ln. 17-24; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>52</sup> Pg. 42, ln. 1-7; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>53</sup> Pg. 42, ln. 8-16; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>54</sup> *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351 (Fed. Cir. 2000).

application, it is presumed that Les Pierres' precast decorative stone to be sold under its mark STONEDGE will move through the ordinary and usual channels of trade for such goods to the usual customers for these products. Furthermore, Les Pierres' description of goods in its application should be construed most favorably to StonCor.<sup>55</sup> When there is no express limitation on the identification of goods, as is the case in Les Pierres' application for STONEDGE, there is a presumption that Les Pierres' goods move through all reasonable trade channels for such goods, including the trade channels in which StonCor's goods move, and are sold to all classes of customers for such goods, presumably including the customers to whom StonCor sells.<sup>56</sup>

Hence, Les Pierres STONEDGE goods and StonCor's STONFIL, STONSET, STONLOK and STONCRETE goods presumptively move in the same trade channels. Therefore, respecting *duPont* factor three, the similarity of established and likely to continue trade channels, StonCor's STONFIL, STONSET, STONLOK and STONCRETE adhesives, mortars and grouts, as well as StonCor's flooring sold under others of the "STON..." marks, and Les Pierres' STONEDGE precast decorative stone, move in the same trade channels. As a result, *duPont* factor three weighs in favor of senior user and registrant StonCor.<sup>57</sup>

*duPont* factor four, the conditions under which and buyers to whom sales are made, as to whether they are impulse buyers or careful, sophisticated purchases, favors StonCor. This

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<sup>55</sup> *David Crystal, Inc. v. Soo Valley Co.*, 471 F.2d 1245, 176 USPQ 326 (C.C.P.A. 1973) *Hercules, Inc. v. National Patent Dev. Corp.*, 524 F.3d 1227, 187 USPQ 668 (C.C.P.A. 1975); *Broderick & Bascom Rope Co. v. Goodyear Tire & Rubber Co.*, 531 F.2d 1068, 189 USPQ 412 (C.C.P.A. 1976) *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986 (C.C.P.A. 1981).

<sup>56</sup> *Centraz Industries Inc. v. Spartan Chemical Company, Inc.*, 77 USPQ2d 1698 (T.T.A.B. 2006); *In re Jump Designs LLC*, 80 USPQ2d 1370 (T.T.A.B. 2006).

<sup>57</sup> Where no trade channels have been included in either the applicant's recitation of services nor in the registration's recitation of services, it is presumed that the applicant and the registrant offer their services in all normal trade channels for such services and to all normal customers for such services. Accordingly, even though StonCor has presented evidence as to the specific trade channels in which StonCor's products in StonCor's "STON..." family of marks move, it is presumed that StonCor's products move in whatever trade channels Les Pierres sells or intends to

follows because StonCor sells to careful, sophisticated purchasers and, in the absence of any evidence to the contrary, presumably Les Pierres would do the same:

Q. I direct your attention to the mark Stonedge as it appears in the upper left-hand corner of that page.

A. Yes.

Q. Do you find some resemblance there between that mark and the marks of StonCor?

A. Yes, very much.

Q. And on what -- what do you -- what do you find -- what is it that makes you say there's some resemblance?

A. Well, it starts with -- it starts with S-t-o-n, because they capitalize the "E," it draws attention to the fact that it's just S-t-o-n and not S-t-o-n-e and that's identical to every mark that Stonhard has filed and owns.

Q. What is identical, the S-t-o --

A. The S-t-o-n as the first half of the name.

Q. Based on your perusal of Exhibit 43 and the products sold by the Applicant under the mark Stonedge, would those products be sold for use in the same -- any of the same applications or markets to whom StonCor promotes its products?

A. Under -- just based on looking at the products themselves, they could be used in commercial construction or those types of applications. Although, many of the photos and things they show are not that. But it's not -- it's not uncommon to see these types of materials used in commercial space, retail, you know, schools, hospitals, those types of applications.

Q. In the public spaces?

A. In the public space, yes.

Q. And StonCor sells flooring for those public spaces --

A. Yes.

Q. -- correct?

A. Yes.<sup>58</sup>

Architects are well educated professionals, not known for being impulse buyers; neither are building managers, nor construction contractors, nor specification writers known for being impulsive when specifying and purchasing needed materials. All of those professionals specify and purchase materials as part of their day-to-day work. When encountering the marks of the respective parties, they will find them in "word only" form. That is the form in which Les Pierres seeks registration of STONEDGE, is the form in which all of StonCor's "STON..."

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sell its STONEDGE products. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937; 16 USPQ2d 1783 (Fed. Cir. 1990).

marks are registered, and is the form in which StonCor's "STON..." marks appear on StonCor's products.<sup>59</sup>

Q. The type of thing that we're seeing here; is that what you're saying?

A. It is possible, yes.

Q. And what trademarks are those products sold under?

A. Stoncrete, Stonset, Stonlok, Stonfil.

Q. And all of the packages of those trademarks would also bear -- or those products, pardon me, all of the packages of any such products would also bear the mark Stonhard --

A. Yes.<sup>60</sup>

StonCor and Les Pierres presumptively sell their goods under the same conditions and to the same buyers, such as architects and construction contractors. StonCor's sales team calls on architects and contractors, as noted by Mr. Jewell<sup>61</sup> and as discussed above in connection with *duPont* factor one. With Les Pierres presenting no evidence respecting sales calls made or representatives retained, it must be presumed that Les Pierres would sell its STONEDGE products under the same conditions as StonCor sells its products under its house mark STONHARD and relevant ones of the "STON..." marks, namely STONFIL, STONLOK, STONSET and STONCRETE, for adhesives, grout, and mortars. *duPont* factor four, the conditions under which and buyers to whom sales are made, favors StonCor.

*duPont* factor five is the fame of the prior mark(s). StonCor's "STON..." marks have been used in many instances for more than twenty years and in one instance for more than eighty years.<sup>62</sup> As per Mr. Jewell's testimony set forth above, StonCor sells and installs its "STON ..." mark products in a minimum of ten thousand projects annually in the United States.

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<sup>58</sup> Pg. 38, ln. 5 through pg. 30, ln. 21; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>59</sup> See StonCor's Exhibits 3, 8 and 9 attached as Appendices B, G and F respectively.

<sup>60</sup> Pg. 29, ln. 20 through pg. 30, ln. 19; StonCor's witness Mr. Jewell's rebuttal testimony; see StonCor's Exhibit 9 accompanying this brief as Appendix F.

<sup>61</sup> Pg. 47, ln. 6 through pg. 48, ln. 20; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>62</sup> Pg. 45, ln. 4; StonCor's witness Mr. Jewell's rebuttal testimony. Based solely on the filing dates of StonCor's use-based applications that matured into StonCor's registrations, STONCRETE has been used since June of 1990;

To maintain and enhance the fame of its “STON...” marks, including STONFIL, STONLOK, STONSET and STONCRETE, StonCor advertises extensively in the United States in magazines targeting StonCor’s markets, whereas there is no evidence that Les Pierres does any advertising or takes any other actions to establish any fame for STONEDGE. Here is Mr. Jewell’s testimony concerning some of StonCor’s print media advertising:

Q. What magazines does StonCor advertise in or contribute to, as we see here?

A. Probably --

Q. How many --

A. About 15 to 20 different magazines.

Q. Name as many of those as you can.

A. Food Processing, Plant Services, Healthcare Building Design, Commercial Building Products, Architectural Building Products, College Planning and Management, School Planning and Management, Animal Lab News, the Pharmaceutical Processing. I'm sure I'm missing many, that's just a handful.

Q. Do you have any idea of combined circulation of all those magazines?

A. Some of the -- the commercial oriented magazines are on the order of usually 30 or 40,000. The more industry specific, like a Food Processing, might be only like ten to 15,000.

Q. Can you tell us approximately what Stonhard spends annually on those advertisements in the print media?

A. In the print media, just right around \$200,000 a year.

Q. And that's for the United States?

A. For the United States, only.<sup>63</sup>

As Mr. Jewell further testified, StonCor puts its umbrella house mark STONHARD on *every* package<sup>64</sup> of *every* product sold under *any* of the StonCor “STON...” marks:

Q. And if those products were being used, the StonCor products were being used in connection with the construction of structures made from the Applicant's precast decorative stone, let me make sure of that, would those products be shipped to a job site in boxes?

A. Yes.

Q. And would those boxes bear trademarks?

A. Yes.

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STONFIL has been used since January of 1991, STONLOK has been used since January of 1990, STONLINER has been used since December of 1990 and STONSET has been used since December of 1989.

<sup>63</sup> Pg. 77, ln. 17 through pg. 78, ln. 19; StonCor’s witness Mr. Jewell’s rebuttal testimony.

<sup>64</sup> See the photographs of representative StonCor product packaging that is StonCor’s Exhibit 9, accompanying this brief as Appendix F.

Q. And what would those trademarks be?

A. Well, they would always include the Stonhard trademark. And then depending upon the product that was being shipped, if it was Stonset, for example, it would list Stonset on the package as well.<sup>65</sup>

Further respecting StonCor's maintenance and enhancement to the fame of StonCor's marks in the course of promoting StonCor's products sold under its "STON..." marks, StonCor promotes its products extensively at various trade shows, at which StonCor's products sold under StonCor's "STON ..." marks are promoted potentially to hundreds of thousands of people:

Q. How many trade shows does StonCor attend in a given year?

A. Typical year, about 25 to 30.

Q. And do you have any idea of the total attendance of those trade shows?

A. No, hundreds of thousands of people when you add it all together.<sup>66</sup>

And, as per Mr. Jewell's testimony set forth below, the StonCor "STON..." marks, namely the house mark STONHARD and particular product marks such as STONFIL, STONCRETE, STONSET, STONLINER, and STONLOK, used on products of interest to attendees at a particular trade show, are prominently displayed at those shows:

Q. And the booth that you would maintain at that trade show, are the trademarks visible?

A. Yes, always the Stonhard trademark. And then depending on the specific show, we may actually list some of the other trademarks if we're trying to promote a specific product or -- or talk to a specific market segment.

Q. Give me an example of a specific product that would be promoted at one show over all of the other products?

A. For example, this year at Healthcare Building Design or Healthcare Design Expo, which is in Florida, we'll have a Stonhard trade show booth and it's very highly likely that we'll be specifically promoting the Stonblend and Stonres product families at that show, because those are targeted really for the healthcare industry.<sup>67</sup>

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<sup>65</sup> Pg. 100, ln. 18 through pg. 101, ln. 9; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>66</sup> Pg. 88, ln. 15-21; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>67</sup> Pg. 89, ln. 5-24; StonCor's witness Mr. Jewell's rebuttal testimony.

StonCor also uses the Internet very effectively to promote its products and, concomitantly, to maintain and to enhance the fame of StonCor's "STON" marks, including STONFIL, STONLOK, STONSET, STONCRETE, and STONLINER. As Mr. Jewell testified, StonCor's website enjoys something approaching or even over 100,000 hits per year:

- Q. Would you identify Exhibit 22 for us?
- A. It's a collection of pages from Stonhard's -- well, two pages -- one page from Stonhard's website. This would be our home page.
- Q. And the text, if you turn it sideways, it's in blue, talks about the different markets that you serve?
- A. Yes.
- Q. And this is the same website you testified earlier that you have 120 something -- approaching -- or over 100,000 hits a year on --
- A. Yes.
- Q. And that's from where the website from which those product data sheets that we identified earlier can be printed?
- A. That is correct.<sup>68</sup>

Of particular significance respecting the effectiveness of StonCor's print advertising and the resulting fame of StonCor's "STON..." marks, including STONFIL, STONLOK, STONSET, STONCRETE and STONLINER, is StonCor's Exhibit 5 setting forth the results of a survey taken in 2006 by the magazine Food Processing, soliciting readers' opinions respecting the best suppliers of various categories of equipment, ingredients, packaging and the like:

- Q. And what is the significance of this page to StonCor and to this proceeding?
- A. We -- we advertise frequently in Food Processing. And once a year Food Processing does an unaided survey where they ask various questions to their respondents. For example, in our case, to name a flooring material or name a flooring supplier to -- they ask a series of questions for them to identify companies that they recognize as the leader in a market space. Or just unaided, name, you know, all the flooring companies that you can think of. And in the bottom left corner you can see the category of flooring. And 24 percent of the time Stonhard was named as -- as a flooring company or as a, you know, quality provider of flooring. I'm not certain as to the nature of the

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<sup>68</sup> Pg. 85, ln. 20 through pg. 86, ln. 13, StonCor's witness Mr. Jewell's rebuttal testimony relating to StonCor's Exhibits 8, 22 and 23, copies of which accompany this brief as Appendices G and I.

question. So we were ranked number 1. And the number 2 is Tufco and they were 7 percent of the time recognized in the survey.<sup>69</sup>

In that survey, the results of which appear in StonCor's Exhibit 5, StonCor's Stonhard Stonclad floor system and flooring ranked first as the flooring of choice as selected by readers of Food Processing in 2006.

StonCor won first place again in 2007:

Q. And would you identify that exhibit?

A. This is a page from a magazine, I'm trying to see here. It's probably Food Processing magazine again. Reader's Choice Awards for 2007. And, again, this is the section or the category Equipment & Packaging. And Stonhard would be the -- well, Flooring is one of the categories. And Stonhard is listed number 1, again, referenced 23 percent of the time. And like the previous one, Tufco is number 2 at 16 percent of the time.

Q. So what is the relevance of this particular piece, Exhibit 5 -- 6, pardon me, to this proceeding?

A. Yes, like 5, the relevance here is that Stonhard is, at least in this venue, Food Processing, the most widely recognized name in the marketplace.<sup>70</sup>

StonCor's Exhibit 7 presents the results of yet another reader survey taken in March of 2009, in which StonCor's STONHARD flooring was the choice of nearly twice as many readers as StonCor's nearest competitor.<sup>71</sup>

Would you tell -- identify what this exhibit is and tell us the relevance to this proceeding?

A. Page from Food Processing Magazine.

Q. What is the date?

A. March 2009. Also Reader's Choice Awards for Equipment, Packaging & Services. Bottom left is Flooring category. Again, Stonhard is number 1, ranked at 25 percent. Sherwin Williams, one of our competitors and Tufco are tied for the second place position at 14 percent of the time.

Q. So, again, does that demonstrate goodwill and recognition of the mark --

A. To us --

Q. -- Stonhard?

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<sup>69</sup> Pg. 63, ln. 9 through pg. 64, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony relating to Exhibit 5.

<sup>70</sup> Pg. 64, ln. 11 through pg. 65, ln. 5; StonCor's witness Mr. Jewell's rebuttal testimony relating to Exhibit 6.

<sup>71</sup> Copies of StonCor's Exhibits 5, 6 and 7 accompany this brief as Appendices C, D, and E respectively.



A. Yes, to us, again, it represents the wide recognition of the mark Stonhard in the marketplace.<sup>72</sup>

These third party surveys, in which StonCor has consistently been named the supplier of choice for flooring, evidence the fame and recognition of StonCor's "STON..." marks including StonCor's house mark "STONHARD", as well as the product marks STONFIL, STONSET, STONLOK, STONLINER and STONCRETE.

Based on the length of time StonCor's "STON..." marks have been used, registered and promoted, the fame of StonCor's "STON..." marks is substantial, as evidenced by the reader surveys discussed above. Contrasting, there is no evidence that Les Pierres' STONEDGE mark has been used or promoted, or that Les Pierres has sold any of its precast decorative stone in this country, so there is no evidence of any fame associated with Les Pierres' mark STONEDGE.

StonCor knows that its advertising has been effective. Exhibit 4, a copy of which accompanies this brief as Appendix H, is a Signet Research Report done for a third party, namely Plant Services magazine. The report concerns the effectiveness of advertisements placed in Plant Services by advertisers such as StonCor. As Mr. Jewell testified, the report confirms the effectiveness of StonCor's advertising and the resultant market and trade recognition of StonCor's marks, particularly StonCor's house mark STONHARD:

Can you identify Exhibit 4 for us?

A. Exhibit 4 is a Signet Research Report for Plant Services Magazine. So it would -- these are independent surveys that are run that the magazine offers to us to show the strength of our advertising and makes suggestions on how our advertising is received in their magazine.

Q. And would you turn back to page 12 of that exhibit?

A. Okay.

Q. And what do you see there?

A. This would be --

Q. Table of some sort?

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<sup>72</sup> Pg. 65, ln. 13 through pg. 66, ln. 7; StonCor's witness Mr. Jewell's rebuttal testimony.

A. A table, yup, an AdEffect table.

Q. And what is the significance of this for StonCor?

A. It shows on this table Stonhard. So Stonhard placed a one-page four color ad on page 51. They gave us an overall AdEffect StonCor of 81. And then they rate the – how many people rated it or what percentage of people surveyed rated our ad as excellent in effectiveness and good in effectiveness.

Q. And are those advertisers ranked in that table?

A. They appear to be ranked by AdEffect score.

Q. And where is Stonhard in the ranking?

A. Number 6.

Q. Are any of the five above Stonhard competitors?

A. No.

Q. Does that ranking have significance to you as respecting StonCor's trademarks?

A. Yes.

Q. What is that significance?

A. It shows -- well, one, it shows the effectiveness of our advertising in our space. In fact, on this list there is only one other competitor listed and they are 12<sup>th</sup> down on the list.<sup>73</sup>

....

Q. And tell us what those two pages are.

A. This appears to be the summary of the actual -- how the score was achieved for the Stonhard -- for Stonhard in that previous table. It's actually showing what percentage of respondents rated our ad as excellent, good, fair, poor. And, in addition, it appears that there is some comments lifted from the various surveys and those are the bullets that are listed here. In fact, the bullets, they're asking the surveyor after seeing the ad in as much detail, tell us your opinion about the advertiser and the products being advertised and what message you feel they're trying to convey. And these bullets represent comments that have been taken out of various surveys.

Q. So the comments represent the reaction of the readers to the ads?

A. Yes.

Q. And from that do you believe there's some correlation with respect to the goodwill associated with the ads and the marks that appear in those ads?

A. Yes.

Q. What do you believe that correlation is?

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<sup>73</sup> Pg. 58, ln. 11 through pg. 60, ln 5; StonCor's witness Mr. Jewell's rebuttal testimony concerning StonCor's Exhibit 4.

A. One, people recognize the name Stonhard. And when you read some of these, you know, you'll see that our advertising also portrays and -- and people are getting that message, that we portray our product through the mark to represent a quality product. It's good for the applications. It's very straightforward. You know, and -- and this reinforces that we're meeting our goal of using the mark to -- to represent the quality of our product.<sup>74</sup>

This evidence shows that StonCor's "STON..." marks, including STONFIL, STONSET, STONLOK, STONLINER and STONCRETE, and the house mark STONHARD, have achieved fame, renown and recognition in the construction industry as a result of StonCor's advertising, trade show participation, website hits and sales calls made by StonCor's sales representatives. Les Pierres presented no any evidence of fame being associated with or acquired by Les Pierres' mark STONEDGE. Accordingly, *duPont* factor five, the fame of the respective parties' marks, favors StonCor.

*duPont* factor six is the number and nature of similar marks in use on similar goods. This weighs in favor of StonCor. StonCor has an active program of opposing marks commencing with the letters "s t o n" that are used on and in connection with construction products<sup>75</sup>,

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<sup>74</sup> Pg. 61, ln. 5 through pg. 62, ln. 19; StonCor's witness Mr. Jewell's rebuttal testimony concerning StonCor's Exhibit 4.

<sup>75</sup> The following is a list of trademark opposition proceedings brought in this country by StonCor Group in connection with StonCor's protection of the "STON..." family of marks: StonCor Group, Inc. v. Cornerstone Wall Solutions, Inc., opposition 91188612; StonCor Group, Inc. v. Specialty Coatings, Inc., opposition 91187787; StonCor Group, Inc. v. Stonexpress, Inc., opposition 91187729; StonCor Group, Inc. v. Stonexpress, Inc., opposition 91187731; StonCor Group, Inc. v. Cupa Materiales, S.A., opposition 91187473; StonCor Group, Inc. v. Daich Coatings Corp., opposition 91185177; StonCor Group, Inc. v. Delaware Quarries, Inc., opposition 91182745; StonCor Group, Inc. v. Aggregate Industries Management, Inc., opposition 91178519; StonCor Group, Inc. v. Stonel, Inc., opposition 91177161; StonCor Group, Inc. v. Menard, Inc., opposition 91174971; StonCor Group, Inc. v. U.S. Floor Corporation, opposition 91173943; StonCor Group, Inc. v. Tomahawk, Inc., opposition 91173583; StonCor Group, Inc. v. Ayiz Bozkurt, opposition 91170709; StonCor Group, Inc. v. Pentair Water Pool and Spa, Inc. and Alliance Trading, Inc., opposition 91169797; StonCor Group, Inc. v. Parador Holzwerke GmbH & Co. KG, opposition 91169978; StonCor Group, Inc. v. Stongard, Inc., opposition 91169256; StonCor Group, Inc. v. B D Classic Enterprises, Inc., opposition 91169060; StonCor Group, Inc. v. The Euclid Chemical Company, opposition 91168700; StonCor Group, Inc. v. Canada Landsnice International Holdings Ltd., opposition 91168640. Additionally StonCor has brought opposition, cancellation, and other proceedings to enforce and protect StonCor's "STON..." marks in Australia, Canada, the European Community Trademark Office, the Benelux Trademark

particularly concrete based and masonry based construction products. Accordingly, the number and nature of such marks in substantial actual use on similar or related goods is small. Les Pierres presented no evidence respecting the number and nature of allegedly similar marks in use on similar goods. Accordingly, *duPont* factor six also weighs in favor of StonCor.

*duPont* factor seven is the nature and extent of any actual confusion; there is no evidence or record of any actual confusion. The chance of any actual confusion having occurred is minimal – there is no evidence that Les Pierres has engaged in any commercial activity in this country respecting its mark STONEDGE nor is there any evidence of sale of the precast decorative stone products for which Les Pierres seeks to register STONEDGE. Therefore, respecting *duPont* factor seven, the nature and extent of any actual confusion, there is no evidence. As a result, with StonCor being the registrant and senior user, *duPont* factor seven, to the extent it applies, favors StonCor.

*duPont* factor eight is the length of time during and conditions under which there has been concurrent use without actual confusion. Les Pierres has not presented evidence of use of Les Pierres’ STONEDGE. Contrasting, StonCor’s uncontroverted evidence establishes that StonCor has completed tens of thousands of projects over the last decade, with StonCor’s “STON” marks appearing prominently around the construction sites, since StonCor applies the relevant StonCor product mark, and StonCor’s house mark STONHARD, to *every* StonCor product shipped to and installed at *every* project site, as per StonCor’s Mr. Jewell’s testimony.

Does the mark Stonhard appear on the products when they're sold?  
A. It appears on all the packaging, as well as on all the literature.<sup>76</sup>

.....

Q. So do other marks appear on individual products as well?

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Office, the United Kingdom, South Africa, Spain, Italy, India, Ecuador and Vietnam. Some of these proceedings have been concluded; others remain pending.

<sup>76</sup> Pg. 19, ln. 19-22; StonCor’s witness Mr. Jewell’s rebuttal testimony.

A. When an individual product is shipped, its packaging would have the Stonhard mark on the -- on the packaging, as well as the -- the name of the individual product. So if it's a, for example, Stonclad, it would be in a box that says Stonclad, but it would also carry the Stonhard mark.<sup>77</sup>

With Les Pierres presenting no evidence regarding *duPont* factor eight, and with StonCor's undisputed evidence establishing that StonCor has complete tens of thousands of projects over the last decade alone, with StonCor's "STON..." marks, including STONFIL, STONSET, STONLOK, STONLINER and STONCRETE, and the house mark STONHARD appearing on the packages of StonCor products shipped to those construction sites, there has been substantial use of StonCor's "STON ..." marks without a whisper of confusion. Accordingly, *duPont* factor eight favors StonCor.

*duPont* factor nine is the variety of goods on which a mark is used or not used and whether the mark is a house mark, one of a family of marks or a product mark. This factor, like all of the other *duPont* factors, favors StonCor because StonCor's "STON..." marks are used on a variety of goods, namely on StonCor's flooring products, on StonCor's coating products and on StonCor's complementary products, such as StonCor's STONFIL, STONSET, STONLOK, STONLINER and STONCRETE adhesives, grouts and mortars. Moreover, StonCor's "STON..." marks include the StonCor house mark STONHARD, as well as all of StonCor's product marks, all commencing with the formative "ston".<sup>78</sup> Contrasting, Les Pierres has not presented any evidence of use of Les Pierres' STONEDGE on *anything*. Since StonCor's "STON..." marks are a family of marks comprising a group of product marks and a house mark, and because the StonCor "STON..." marks are used on a wide variety of goods for which those marks are registered, *duPont* factor nine favors StonCor.

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<sup>77</sup> Pg. 20, ln. 7-15; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>78</sup> Pg. 49, ln. 1-24; StonCor's witness Mr. Jewell's testimony-in-chief.

*duPont* factor ten is the mark and interface between the applicant and the owner of a prior mark, and whether there is any consent to register or to use, or other agreement between the parties, or assignment of any of the marks; none of this applies here. There is no evidence of any consent or agreement of any type between the parties. To the contrary, StonCor strongly opposes Les Pierres' application.

*duPont* factor eleven is the extent to which an applicant has the right to exclude others from use of its mark on its goods. Les Pierres has presented no evidence of having any use rights whatsoever, or any common law rights anywhere in the United States of America. Contrasting, fifteen of StonCor's "STON..." marks, including STONFIL, STONSET, STONLOK, STONLINER and STONCRETE, are incontestably registered and hence provide StonCor with the nationwide right to exclude others from using those registered marks, to say nothing respecting StonCor's common law rights in its marks that are registered and in its marks that are in use and pending registration, of which there are a number as noted above. Accordingly, *duPont* factor eleven favors StonCor.

*duPont* factor twelve is the extent of potential confusion, i.e. whether *de minimis* or substantial. The extent of *potential* confusion is substantial *if* Les Pierres begins to do business in the United States. StonCor has customers throughout the United States. With the number of StonCor projects each year in the United States being between 10,000 and 15,000, as per Mr. Jewell's testimony set forth above,<sup>79</sup> there surely is the potential for very substantial confusion of architects, specifiers, building owners, and general contractors as between Les Pierres' mark STONEDGE and some or all of the StonCor "STON..." marks, especially STONFIL, STONLOK, STONSET, STONCRETE, and STONLINER:

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<sup>79</sup> Pg. 13, ln. 22 through pg. 14, ln. 9; StonCor's witness Mr. Jewell's rebuttal testimony.

Q. You think a general contractor seeing a package of precast decorative stone labeled Stonedge might think that that was a product of StonCor?

A. It's possible. It depends on how the package is presented and -- and the typeface and -- and whatever used to identify the product.<sup>80</sup>

...

And the same question with respect to a general contractor hearing about a, quote, precast decorative stone product and hearing that the product was sold under the mark Stonedge, would he believe that product was a product of StonCor?

A. He could certainly believe that.<sup>81</sup>

...

Q. Do you think it likely that an architect seeing the mark Stonedge would think that denoted a product of StonCor?

A. I think likely, yes.

Q. You think it's likely that an architect hearing the mark Stonedge pronounced would believe that mark identified a product of StonCor?

A. Yes.<sup>82</sup>

Accordingly, *duPont* factor twelve favors StonCor.

*duPont* factor thirteen is any other established fact probative of the effect of use; there is no evidence of record relevant to this factor.

On balance the *duPont* factors clearly weigh in favor of senior user StonCor and StonCor's "STON" marks, particularly the product marks STONFIL, STONLOK, STONSET, STONCRETE, and STONLINER, and the house mark STONHARD.

When marks are used in connection with identical goods, or closely related goods, as is the case here, the degree of similarity in the competing marks needed to find likelihood of confusion declines.<sup>83</sup> Goods need not be identical for likelihood of confusion; they need only be related. Mortar is used in the installation of Les Pierres' precast decorative stone<sup>84</sup>; a contractor

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<sup>80</sup> Pg. 41, ln. 17-24; StonCor's witness Mr. Jewell's rebuttal testimony

<sup>81</sup> Pg. 42, ln. 1-7; StonCor's witness Mr. Jewell's rebuttal testimony

<sup>82</sup> Pg. 42, ln. 8-16; StonCor's witness Mr. Jewell's rebuttal testimony

<sup>83</sup> *Century 21 Real Estate Corp. v. Century Life America*, 970 F.2d 874 (Fed. Cir. 1992).

<sup>84</sup> See Les Pierres' STONEDGE installation guide, calling for "mortar" to install the STONEDGE precast decorative stone product. The Les Pierres STONEDGE installation guide is a part of Exhibit 43, and accompanies this brief as a part of Appendix J.

installing Le Pierres' precast decorative stone could buy the required mortar from StonCor.

Consistent with this position, Mr. Jewell for StonCor testified that StonCor's mortar or grout could be used to install Les Pierres' precast decorative stone:

Would you turn to page LPS0025 of Exhibit 43?

A. Okay.

Q. And what -- and what do you see there?

A. It's another specification page for Stonedge Series Techno-Bloc.

They appear to be -- well, this says 45-degree corners. So it's a block with a beveled edge on it.

Q. And could -- could the same -- how would these pieces be installed?

A. Well, based on the photograph at the bottom, they appear to be used to -- if they're used on a wall surface, I would guess where the -- a corner meets or if they -- you just wanted a beveled edge on your -- on your, you know, wall or whatever that you were building.

Q. And would any of the StonCor products that you described earlier, the mortars and grouts be used in such installation?

A. They could be, yes.<sup>85</sup>

From Mr. Jewell's undisputed testimony, adhesive, grout and mortar such as is produced by StonCor is needed to install Les Pierres' precast decorative stone. With StonCor's adhesives, grouts and mortars sold under StonCor's marks STONFIL, STONLOK, STONSET, STONCRETE, and STONLINER being useful to install Les Pierres STONEDGE precast decorative stone, there is a clear relationship between the goods of the respective parties, further weighing in favor of a finding of likelihood of confusion.

As to StonCor's remaining flooring products, lining products and complementary products sold under various ones of the StonCor "STON..." marks, for likelihood of confusion it is sufficient if those goods are related in some manner to Les Pierres' precast decorative stone in circumstances surrounding the use of the respective parties' goods so that person could form mistaken beliefs that the respective goods originate from or are in some way associated with the

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<sup>85</sup> Pg. 32, ln. 18 through pg. 33, ln. 14; StonCor's witness Mr. Jewell's rebuttal testimony.



same source, or that there is an association or connection between the sources of the respective goods or services.

StonCor's "STON" marks, especially STONFIL, STONLOK, STONSET, STONCRETE, STONLINER and StonCor's house mark STONHARD, and Les Pierres' mark STONEDGE, were it in use, would most likely be encountered by the same architects, specifiers, general contractors and building superintendents and owners in presentations made by StonCor's sales representatives and by whomever would promote Les Pierres' STONEDGE precast decorative stone. As a result, if Les Pierres' STONEDGE was in use, it is highly likely that an architect or building contractor, etc. receiving a sales presentation could form the mistaken belief that the respective goods offered under the StonCor marks STONLOK, STONSET, STONCRETE, STONLINER, and STONHARD, and Les Pierres' mark STONEDGE, originated from or were in some way associated with the same source, namely StonCor as the registrant and senior user of the family of StonCor "STON..." marks.

### **StonCor's Family of "STON..." Marks Must be Protected from Encroachment by Les Pierres' STONEDGE**

The StonCor family of marks encompasses many marks, all commencing with the formative "s t o n", which enables customers to identify StonCor's many products. Mr. Jewell testified that StonCor floors installed in industrial, institutional and commercial buildings, StonCor chemically resistant lining materials, and all of StonCor's complementary adhesives, grouts, mortars, etc. that go with the floors, are all sold under the "STONHARD" umbrella house mark.

Does the mark Stonhard appear on the products when they're sold?

A. It appears on all the packaging, as well as on all the literature.<sup>86</sup>

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<sup>86</sup> Pg. 19, ln. 19-22; StonCor's witness Mr. Jewell's rebuttal testimony.

.....

Q. So do other marks appear on individual products as well?

A. When an individual product is shipped, its packaging would have the Stonhard mark on the -- on the packaging, as well as the -- the name of the individual product. So if it's a, for example, Stonclad, it would be in a box that says Stonclad, but it would also carry the Stonhard mark.<sup>87</sup>

StonCor's marks are a family of marks having a highly recognizable common characteristic -- they all commence with the formative "S T O N". Moreover, the marks are composed and used in such a way that persons in the relevant market, namely architects, specifiers, general contractors, building managers and owners, building superintendents, and the like, to whom StonCor promotes its products, associate the many individual marks and also the "S T O N" characteristic of the mark family with StonCor.

Q. Okay. What are the importance of these trademarks owned by StonCor, if any?

A. We believe that they are, you know, representative of -- of Stonhard and our position in the marketplace. They're all selected because of their inter-relation to the name Stonhard.<sup>88</sup>

In contests involving determinations of likelihood of confusion, senior users are accorded preference and conflicts in the evidence and doubts are resolved against the junior user:

In determining whether [applicant's mark] is likely to cause confusion or mistake or to deceive as to the source of [goods], preference is accorded the prior user of a mark or family of marks, as against a newcomer.<sup>89</sup>

StonCor has used some of its registered STON... marks for more than twenty years<sup>90</sup>, in some cases for considerably more than twenty years.

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<sup>87</sup> Pg. 20, ln. 7-15; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>88</sup> Pg. 19, ln. 8-14; StonCor's witness Mr. Jewell's rebuttal testimony.

<sup>89</sup> *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1466 (Fed. Cir. 1991).

<sup>90</sup> StonCor's registrations of its "STON..." trademarks on the Principal Register is *prima facie* evidence of StonCor's continuous use of those marks dating back to the filing dates of each of the use-based applications which matured into those registrations. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435 (C.C.P.A. 1965). Note that USSN 74/008,263 for STONCLAD was filed on 6 December 1989; USSN 74/416,188 for

- Q. How long has the mark Stonhard been used as a trademark or as a part of a – as a trademark, let's start with that, to your knowledge?
- A. To my knowledge, since 1922.<sup>91</sup>

StonCor, relying on its registered “STON...” marks, is entitled to a *prima facie* presumption of ownership and use, totally apart from any supporting evidence.<sup>92</sup> Accordingly, preference should be accorded to StonCor and against Les Pierres, especially where Les Pierres has presented no evidence to rebut StonCor's *prima facie* evidence of ownership, use and similarity in the sound, appearance and connotation, and StonCor's showing of identity of trade channels. With Les Pierres having presented no such evidence, despite Les Pierres having the burden, registration of Les Pierres' STONEDGE should be refused.<sup>93</sup>

Case law supports StonCor's position regarding the favorable evidentiary presumptions to be accorded to StonCor vis-à-vis Les Pierres in light of StonCor's ownership of a family of marks.<sup>94</sup> Instructive is *Nina Ricci, S.A.R.L.* in which the Federal Circuit reversed this Board's dismissal of an opposition brought by an owner of a family of marks<sup>95</sup> noting that the reversible

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STONCLAD-PT was filed on 7 March, 1983; USSN 74/008,252 for STONCREST was filed on 6 December 1989; USSN 74/018,802 for STONCRETE was filed on 16 January 1990; USSN 74/128,918 for STONFIL was filed on 2 January 1991; USSN 74/008,262 for STONGLAZE was filed on 6 December 1989; USSN 73/655,185 for STONHARD was filed on 10 April 1987; USSN 73/828,632 for STONKOTE was filed on 2 October 1989; USSN 74/008,251 for STONLINER was filed on 6 December 1990; USSN 74/019,904 for STONLOK was filed on 17 January 1990; USSN 74/008,264 for STONLUX was filed on 6 December 1989; USSN 74/012,827 for STONPROOF was filed on 21 December 1989; USSN 74/012,844 for STONSEAL was filed on 21 December 1989; USSN 74/008,265 for STONSET was filed on 6 December 1989; USSN 74/008,256 for STONSHIELD was filed on 6 December 1989.

<sup>91</sup> Pg. 44, ln. 24 through pg. 45, ln. 4; transcript of Mr. Jewell's rebuttal testimony.

<sup>92</sup> 15 USC 1115(a) and 1115(b); *Gillette Co. v. Kempel*, 254 F.2d 402; 117 USPQ 356 (C.C.P.A. 1958); *General Shoe Corp. v. Lerner Bros. Mfg. Co.*, 254 F.2d 154; 117 USPQ 281 (C.C.P.A. 1958).

<sup>93</sup> *American Throwing Co. v. Famous Bathrobe Co.*, 250 F.2d 377; 116 USPQ 156 (C.C.P.A. 1957).

<sup>94</sup> *McDonald's Corp. v. McBagel's, Inc.*, 649 F.Supp. 1268 (S.D.N.Y. 1986); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333 (Fed. Cir. 2001); *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070 (Fed. Cir. 1989); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460 (Fed. Cir. 1991).

<sup>95</sup> *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 1071 (Fed Cir. 1989).

error was the Board's failure "to consider the other marks of opposer and their effect on the similarity or dissimilarity of" the applicant's mark.<sup>96</sup>

In *Nina Ricci, S.A.R.L.* the Federal Circuit recognized that the other marks, which were farther from the applicant's mark than the single mark asserted by the registrant, evidenced that the formative "RICCI" defined a family of marks, was a unifying presence in the opposer's marks, and was the dominant and significant part of each of the opposer's marks in identifying the opposer's goods.

The same is true of the "S T O N" formative of StonCor's family of marks. The letters "S T O N" are the unifying prefix in the StonCor marks and constitute a unifying, dominant part of each member of StonCor's family of "STON..." marks identifying StonCor as the source of origin of its' products and services. This being the case, judgment should be rendered in favor of StonCor, denying Les Pierres' application.

Also supporting StonCor is *McDonald's Corp. v. McBagel's, Inc.* where the United States District Court for the Southern District of New York held that if McDonald's could demonstrate that it had established a family of marks, McDonald's could obtain trademark protection against a third party mark thought by relevant purchasers to identify goods emanating from McDonalds.<sup>97</sup> The court found a family of marks based on a common formative component and other factors including the extent of use of the family of marks, advertising and promotion using the marks of the family, and the inclusion of a number of unregistered and registered marks all owned by the same entity.<sup>98</sup> The court held that McDonald's was able to use

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<sup>96</sup> Id. at 1073.

<sup>97</sup> *McDonald's Corp. v. McBagel's, Inc.*, 649 F. Supp. 1268 at 1272 (S.D.N.Y. 1989)

<sup>98</sup> Id.

its family of marks as a basis for trademark enforcement because the “Mc” formative was extensively used, widely promoted, and actively policed.<sup>99</sup>

Here, StonCor has a large number of registered marks, as well as a number of unregistered marks and trade names, all having the letters “S T O N” at the beginning of the mark.<sup>100</sup> As per Mr. Jewell’s testimony set forth and referenced above, and StonCor’s Exhibits 4, 5, 6, and 7, there has been extensive, very successful advertising and promotion of all of the StonCor Group products bearing the “STON...” marks that make up StonCor’s mark family. As Mr. Jewell also testified, the common formative component, namely the letters “S T O N” (without any “e”) is highly distinctive. Just looking at that string of letters by itself, at the beginning of each of the StonCor marks, one clearly sees the distinctiveness of the “S T O N” letter combination in such context:

Q. Anything else, Mr. Jewell, that you would like to add regarding this issue of confusion or likelihood of confusion between the Applicant's mark, Stonedge, when used in connection with precast decorative stone and StonCor and StonCor's marks and products sold under those marks?

A. Yeah, the only thing is, is that, you know, we've put a great deal of effort and energy over the years into being very, very consistent with our naming schemes, as well as our trademark filings to really associate within the building and construction industry anything that's Ston "blank" associated with Stonhard. We -- we have a very purposeful naming scheme that always includes "Ston blank." We would not ever consider a product that was -- didn't start with S-t-o-n. And, in fact, we believe that in the marketplace Ston "blank" in the building and construction industry is generally recognized as a Stonhard product.

Q. And when you say Ston "blank" you mean S-t-o-n "blank" as contrasted to S-t-o-n-e?

A. Yes, S-t-o-n "blank."<sup>101</sup>

The analogy to *McDonald's Corp.* is quite apt. While McDonald’s focuses on a market of 300,000,000 consumers, StonCor focuses on a market of 20,000 architects, general contractors,

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<sup>99</sup> Id.

<sup>100</sup> See Footnote 13 above, detailing StonCor’s unregistered “STON” marks and StonCor’s trade names commencing with “STON”.

<sup>101</sup> Pg. 102, ln. 24 through pg. 103, ln. 24; StonCor’s witness Mr. Jewell’s rebuttal testimony.

building superintendents and the like. Both McDonald's and StonCor have unique, proprietary products that McDonald's and StonCor sell under their respective families of marks. Both McDonald's and StonCor's families of marks are well recognized by their respective customers in their target markets. McDonald's and StonCor both vigorously protect and enforce the marks that are members of their respective mark families. Both McDonald's and StonCor spend substantial sums in promoting the recognition and goodwill associated with their mark families through advertising in specific media directed towards their respective target markets, and on the Internet. Both McDonald's and StonCor have enjoyed great success with each being "number one" in its respective field. Thus, as in *McDonald's Corp.*, StonCor's family of marks is entitled to protection from encroachment by Les Pierres' STONEDGE mark because the marks commencing with the "S T O N" formative have been extensively used, widely promoted, recognized by the relevant trade, and actively policed. Judgment should be rendered in favor of StonCor and against Les Pierres, denying Les Pierres' application.

### **Evidentiary Preference Goes to StonCor, as Senior User and Registrant**

Les Pierres as the newcomer had the clear opportunity, if not the obligation, to avoid confusion with StonCor's well-known marks.<sup>102</sup>

[W]here there is any doubt on the question of the likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so.<sup>103</sup>

StonCor's principal witness, Mr. Michael Jewell, is a graduate mechanical engineer, the Vice President of Marketing of StonCor, and has 22 years of experience in the construction and building field that StonCor serves. He testified that StonCor's business was manufacture, sale, installation and service of specialty flooring and protective coating products. Mr. Jewell further

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<sup>102</sup> *Harold F. Ritchie, Inc. v. Chesebrough-Pond's Inc.*, 287 F.2d 755, 758 (2nd Cir. 1960).

testified that StonCor's principal customers are builders, architects and general contractors, building managers, and the like, as well as end users or owners of buildings.

Mr. Jewell further testified that StonCor's products directed to the construction field are identified by the trademarks StonCor owns for its products including the trademarks "STONHARD", "STONCLAD", "STONKOTE", "STONSHIELD", "STONBLEND", "STONCLAD-PT", "STONCREST", "STONCRETE", "STONFIL", "STONLINER", "STONLOK", "STONLUX", "STONPROOF", "STONSET" and "STONSEAL".

When asked as to the importance of the "STON..." marks owned by StonCor, Mr. Jewell testified that StonCor's "STON..." trademarks, individually and collectively, have come to be recognized by the building and construction industry as collectively denoting StonCor's products:

Q. Anything else, Mr. Jewell, that you would like to add regarding this issue of confusion or likelihood of confusion between the Applicant's mark, Stonedge, when used in connection with precast decorative stone and StonCor and StonCor's marks and products sold under those marks?

A. Yeah, the only thing is, is that, you know, we've put a great deal of effort and energy over the years into being very, very consistent with our naming schemes, as well as our trademark filings to really associate within the building and construction industry anything that's Ston"blank" associated with Stonhard. We -- we have a very purposeful naming scheme that always includes Ston"blank." We would not ever consider a product that was -- didn't start with S-t-o-n. And, in fact, we believe that in the marketplace Ston"blank" in the building and construction industry is generally recognized as a Stonhard product.

Q. And when you say Ston"blank" you mean S-t-o-n" blank" as contrasted to S-t-o-n-e?

A. Yes, S-t-o-n" blank." <sup>104</sup>

Additionally, Mr. Jewell testified that due to extensive use by StonCor of its' "STON..." trademarks and the extensive sale and promotion of products under those marks, the four-letter

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<sup>103</sup> *Recot, Inc. v. Becton*, 56 USPQ2d 1859, 1862 (T.T.A.B. 2000); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460 (Fed. Cir. 1991).

<sup>104</sup> Pg. 102, ln. 24 through pg. 103, ln. 24; StonCor's witness Mr. Jewell's rebuttal testimony.

prefix of those marks, namely the letter string “S T O N”, has acquired recognition upon sight in the minds of StonCor’s customers and the trade as denoting StonCor products. Mr. Jewell testified that use of a trademark commencing with the four letter string “S T O N” such as Les Pierres’ STONEDGE is likely to cause confusion with one or more of StonCor’s “STON...” marks, which could result in the third party making a sale rightfully belonging to StonCor:

And the same question with respect to a general contractor hearing about a, quote, precast decorative stone product and hearing that the product was sold under the mark Stonedge, would he believe that product was a product of StonCor?

A. He could certainly believe that.<sup>105</sup>

...

Q. Do you think it likely that an architect seeing the mark Stonedge would think that denoted a product of StonCor?

A. I think likely, yes.

Q. You think it's likely that an architect hearing the mark Stonedge pronounced would believe that mark identified a product of StonCor?

A. Yes.<sup>106</sup>

Q. Do you believe that a typical general contractor to whom StonCor might sell seeing the mark Stonedge would think that product identified a product of StonCor?

A. I do believe it's possible that they would see that, especially if they saw it printed in -- in a specification or -- or a place where the mark is just being referenced to as -- as a product.<sup>107</sup>

When questioned as to whether any of the “STON...” products sold by StonCor could be used in connection with the installation or maintenance of the products presumably sold under the mark “STONEDGE”, Mr. Jewell testified in the affirmative and identified several StonCor products that might be so-used. Specifically, he said that mortar or adhesive, as made and sold by StonCor under StonCor’s marks STONLOK, STONSET, STONFIL and STONCRETE, could be used in the installation of Les Pierres’ product:

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<sup>105</sup> Pg. 42, ln. 1-7; StonCor’s witness Mr. Jewell’s rebuttal testimony.

<sup>106</sup> Pg. 42, ln. 8-16; StonCor’s witness Mr. Jewell’s rebuttal testimony.

<sup>107</sup> Pg. 39, ln. 22 through pg. 40, ln. 6; StonCor’s witness Mr. Jewell’s rebuttal testimony.



Q. And what are the product -- or how would you describe the product that's shown there on document -- page 0009 of Exhibit 43?<sup>108</sup>

A. Well, according to the -- the heading on the document, it's a pillar cap, which I imagine in this picture is the very top of those pillars. And it appears to be made of either stone or some sort of composite material. And it's all printed in French, so...

Q. On the basis of what you're inferring or the implications you're taking from the document there and the -- the assumption you're making about the product, how would that product be installed?

A. By -- by whom or how?

Q. No. How? What materials would be used; what would be done; how would it be installed?

A. I would -- my estimate it would be installed using either mortar or an adhesive to -- to build the pillars and cap them. Generally, it's either a **cement mortar or some sort of polymer modified mortar or adhesive** that's used to hold these things together.

Q. And does StonCor make and sell any product or products that could be used to fulfill that function?

A. **We make products that could be used as the mortar or adhesive layers**, not the actual capping stone.

Q. And what trademarks are those products sold under?

A. **Stonlok, Stoncrete, Stonset, Stonfil are all used for those types of -- could be used for those types of applications.**<sup>109</sup> (emphasis added)

When asked to whom the precast decorative stone, for which Les Pierres seeks registration of STONEDGE, would be presumably be sold, Mr. Jewell testified that those products would be promoted and sold to the same customers and potential customers to whom StonCor promotes its products, namely to architects, engineers, construction managers, designer-builders, general contractors, specifiers, interior designers, and consultants:

Q. And then down the very bottom, what does -- what -- what do they - - what is the group at the very bottom? Read that --

A. At the specifier level, yeah, that's architects, engineers, construction managers, design-builders, general contractors, interior designers, consultants.

Q. So these are -- that's the same group generally that you identified earlier as being the people to whom you direct your marketing efforts?

A. Yes, one of the groups who we direct our marketing efforts to, yes.

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<sup>108</sup> StonCor's Exhibit 43 is a collection of Les Pierres promotional literature for Les Pierres' STONEDGE precast decorative stone, selected pages of which accompany this brief as Appendix J.

<sup>109</sup> Pg. 27, ln. 12 through pg. 28, ln. 24; StonCor's witness Mr. Jewell's rebuttal testimony addressing certain of Les Pierres' STONEDGE promotional literature.

Mr. Jewell went on to testify that the products, for which registration of Les Pierres STONEDGE is sought, presumably would be promoted and sold to the same customers and potential customers to whom StonCor promotes its products, namely general contractors, architects, building superintendents, building managers, building owners, etc., with all of those StonCor products being sold under marks commencing with the formative “S T O N”.

Q. Do you believe that a typical general contractor to whom StonCor might sell seeing the mark Stonedge would think that product identified a product of StonCor?

A. I do believe it's possible that they would see that, especially if they saw it printed in -- in a specification or -- or a place where the mark is just being referenced to as -- as a product.<sup>111</sup>

As set forth above, Mr. Jewell testified that a typical general contractor seeing or hearing Les Pierres' mark would believe that mark identified a product of StonCor due to presence of the formative “s t o n” as the first four letters of Les Pierres' mark. As further presented above, Mr. Jewell's testimony was essentially the same regarding, architects and building managers, namely that all of these professionals upon seeing or hearing the mark “STONEDGE” would believe the mark identified a StonCor product due to the presence of StonCor's formative “S T O N” as the first part of the mark.

If Les Pierres' mark is registered pursuant to application 76/650,832, Les Pierres Stonedge, Inc. will acquire the *prima facie* exclusive right to use the mark STONEDGE on and in connection with precast decorative stone throughout the United States. This will damage StonCor in that there is likelihood of confusion, and probably would be actual confusion, among consumers and in the trade as to the true source of origin of the adhesive, grout and mortar sold under the StonCor “STON” marks STONLOK, STONFIL, STONLINER, STONSET, and

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<sup>110</sup> Pg. 93, ln. 9-21; StonCor's witness Mr. Jewell's rebuttal testimony.

STONCRETE vis-à-vis the precast decorative stone presumably to be sold by Les Pierres under the STONEDGE mark. As the newcomer, Les Pierres should have sought to avoid such likelihood of confusion when selecting its mark. This Board can assist Les Pierres, in belatedly fulfilling its newcomer's obligation to avoid confusion with StonCor's marks, by sustaining this opposition in favor of StonCor.

### **Summary of the Evidence and Prayer for Relief**

StonCor's evidence includes 15 incontestable United States trademark registrations for marks commencing with the formative "STON", the testimony of Mr. Michael Jewell, StonCor's Vice President for Marketing and Sales, and documentary exhibits, including third party surveys evidencing the high visibility and trade recognition of StonCor's "STON" marks, including STONFIL, STONLOK, STONSET and STONCRETE, and StonCor's house mark STONHARD.

Contrasting, Les Pierres presented no evidence in support of its position; the only evidence of record for Les Pierres' is the STONEDGE application as filed.

Weighing StonCor's marks "STONHARD", "STONCLAD", "STONKOTE", "STONSHIELD", "STONBLEND", "STONCLAD-PT", "STONCREST", "STONCRETE", "STONFIL", "STONLINER", "STONLOK", "STONLUX", "STONPROOF", "STONSET" AND STONSEAL" and Les Pierres' STONEDGE mark against the applicable *duPont* factors tilts the scale heavily in favor of StonCor and against Les Pierres. There can be no doubt that Les Pierres should be denied registration.

With Les Pierres' eight letter mark appropriating the first four letters of StonCor's family of "S T O N" marks, with such family consisting of fifteen registered, incontestable marks, some of which have been in use for well over 20 years, many of which also have eight letters, and all

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<sup>111</sup> Pg. 39, ln. 22 through pg. 40, ln. 6; StonCor's witness Mr. Jewell's rebuttal testimony.

of which share the same formative “S T O N” defining the StonCor mark family; and with Les Pierres’ and StonCor’s goods presumptively being offered and sold to the same customers and in some cases being functionally complementary, there is a strong likelihood of confusion.

Registration for STONEDGE should be denied.

The law requires viewing the evidence most favorably for StonCor as the senior user/registrant/opposer. Les Pierres, having presented no evidence in the proceeding and having only its application as filed in support of its position, should be denied registration for STONEDGE.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this brief and/or any accompanying papers, please charge all such fees to Deposit Account 50-1943.

Respectfully submitted,

Date: 4 January 2010

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**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.	:	
	:	
v.                      Opposer	:	
	:	Opposition 91181621
	:	
	:	Application 76/650,832
	:	
Les Pierres Stonedge, Inc.	:	
	:	
Applicant	:	

**CERTIFICATE OF SERVICE**

I, Charles N. Quinn, of full age, by way of certification, state that a copy of StonCor's Principal Brief in Support of StonCor's Case-In-Chief with Appendices was served on applicant's counsel on the date set forth below via electronic mail and first class mail, postage prepaid, addressed as follows:

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Date: 4 January 2010

/Charles N. Quinn/  
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